

R1994-3

In re _____)
)
) Decision on Petition
) for Review under
) 37 CFR § 10.2(c)
)

(petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED), dated March 22, 1994, which denied the petitioner's request for higher scores on Part I of the afternoon section of the Registration Examination for Patent Attorneys and Agents held on October 13, 1993.

The Director's decision of March 22, 1994, is affirmed.
The petitioner is not entitled to any additional points on the
score achieved for the afternoon section of the examination.

The afternoon section of the examination consist of two parts. Part I consists of a single claim drafting question worth 60 points. Part II consists of Multiple Choice Question Nos. 1-8 worth 5 points each. To pass the afternoon section of the examination, 70 points had to be achieved.

The petitioner had 25 points deducted from his score for answering five multiple choice questions incorrectly. On the claim drafting question, 13 points were deducted. Accordingly, the petitioner achieved a combined score of 62 points for the afternoon section of the examination, 8 points short of a passing grade.

On January 11, 1994, the petitioner requested a regrade of the claim drafting question. On February 3, 1994, the OED issued a regrade decision which determined that the petitioner was not entitled to any additional points for the claim drafting question.

On February 17, 1994, the petitioner requested reconsideration by the Director of OED. The Director's decision was issued on March 22, 1994. The Director determined that the petitioner was not entitled to any additional points on the claim drafting question.

The petitioner then requested review by the Commissioner under 37 CFR § 10.2(c).

Opinion

In answering the claim drafting question, the petitioner had an option to work with any one of three different disclosed inventions -- a mechanical invention, a chemical invention, and an electrical invention. The petitioner chose the mechanical invention which is directed to a shaving implement.

A specification of the invention was provided by the question, including a paragraph entitled Objects of the Invention, figures showing two embodiments of the invention, and detailed written description of the two embodiments.

The question contained these instructions:

Draft THREE (3) CLAIMS: a single independent claim and two dependent claims to a shaving implement. The generic claim (claim 1) must be the

broadest claim for the shaving implement which defines the invention as set forth in the OBJECTS OF THE INVENTION, which includes any critical limitations, and which is not anticipated by the prior art. One dependent claim (claim 2) must cover the specific embodiment shown in FIGS. 1 through 3 and further include the relatively rotatable first and second closure parts with the cooperating interior chamber, passages, and angled conduit. The other dependent claim (claim 3) must cover the specific embodiment shown in FIGS. 4 through 6, including handle openings, the plug, and the threaded closure cap. The generic claim is worth 40 points and each dependent claim is worth 10 points. Your claims must be drawn to a shaving implement, and you must adhere to the following requirements. You may not be your own lexicographer to name the elements or components of the disclosed invention or to rename elements or components of the shaving implement. You must use the terminology of the described invention. Any method claim or Jepson claim will receive no credit. Points will be deducted for (1) claiming subject matter not within the scope of the invention disclosed above; (2) using claim language which is vague or indefinite,

(3) using claim language which does not have antecedent basis or which does not positively set forth each element or component; (4) failing to interrelate or incorrectly interrelating the elements or components set forth in your claims, (5) claiming unnecessary limitations in generic claim 1; (6) presenting a claim that defines an inoperative invention or that is anticipated by the prior art; (7) using poor grammar and misspelled words, and (8) failing to follow these directions. [Emphasis in original.]

Thus, generic claim 1 has to be the broadest claim:

- A. Which defines the invention as set forth in the Objects of the Invention paragraph;
- B. Which includes any critical limitations; and
- C. Which is not anticipated by prior art.

The Objects of the Invention paragraph is reproduced below:

OBJECTS OF THE INVENTION

The present invention provides an improved shaving implement by overcoming the disadvantages mentioned above relative to the prior art shaving implement. The main object of the invention is to provide a shaving implement which can dispense shaving cream for the lifetime of the razor. A further object of the invention is to provide a handle having a channel with longitudinal sides and a chamber for holding a

collapsible tube of shaving cream so that when a tube closure is in its open position, a tube squeezing slide, positioned in the channel and chamber of the handle, can be moved by a user to cause opposed slots of the slide to ride on the longitudinal sides of the channel such that shaving cream from the tube can be selectively dispensed from a dispensing opening in a neck of the collapsible tube. [Emphasis added.]

Five points were deducted from the petitioner's score because petitioner's claim 1 did not include the limitation that the handle of the shaving implement has "longitudinal sides." Five points were deducted from the petitioner's score because petitioner's claim 1 did not include the limitation that the tube squeezing slide has "opposed slots." The Model Answer to the claim drafting question regards both limitations to be necessary limitations which must be included in claim 1.

The petitioner argues that the instructions to this question require neither the "longitudinal sides" feature of the channel in the handle nor the "opposed slots" feature of the tube squeezing slide to be included in claim 1. According to the petitioner, a "necessary limitation" is merely:

- (1) to distinguish the invention over the prior art;
- (2) for operability of the invention; and
- (3) to interrelate the implements set forth in the claims.

With respect to the "longitudinal sides" and "opposed slots" features of the invention, the petitioner further states:

Including these limitations would necessarily compromise the service rendered to a client, since their inclusion unduly limits the scope of any patent that might be obtained, thereby allowing would-be infringers to design around the claims and avoid infringement.

The petitioner's arguments are without merit. Drafting the broadest claim with sufficiently interrelated component parts for an operable shaving implement which defines over the prior art is not the only consideration required by the question asked. The structural features described in plain English within the Objects of the Invention paragraph must also be identified and presented in the form of elements within a patent claim. The question directs examinees not simply to draft the broadest definite and operable claim which defines over the prior art, but the broadest claim:

- A. Which defines the invention as set forth in the Objects of the Invention paragraph;
- B. Which includes any critical limitations; and
- C. Which is not anticipated by prior art.

The petitioner must answer the question asked. Defining the invention as set forth in the Objects of the Invention paragraph is an explicit requirement of the question. On the basis of the instructions given, it would be unreasonable to interpret the claim drafting question such that the

requirement of defining the invention as set forth in the Objects of the Invention paragraph is omitted or otherwise ignored.

While it is true that the instructions do state that points will be deducted for claiming unnecessary features, the features described in the Objects of the Invention paragraph are not unnecessary. Rather, as discussed above, they are required to be present in generic claim 1.

Additionally, even if we assume that the petitioner's interpretation of what limitations are necessary is reasonable, the petitioner had to draft the broadest claim possible having the fewest features of the disclosed invention, which is not anticipated by prior art. The petitioner has failed in that regard as well.

Anticipation requires that each element of a claim be found in a single prior art reference. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, if more than one element in petitioner's claim 1 is not found in a single prior art reference, the petitioner has claimed unnecessary features. Even under petitioner's interpretation, his claim 1 contains limitations beyond what is necessary to avoid anticipation by prior art. Indeed, petitioner even states:

My generic claim included the following elements not taught or shown in the prior art:

- (1) a chamber formed by the handle, a chamber substantially running the length of the handle;
- (2) a collapsible tube of shaving cream, a collapsible tube having a neck and being substantially internally positioned within the chamber, the collapsible tube substantially filling the chamber;
- (3) a channel defined by the top side of the handle, the channel communicating over substantially its entire length with the chamber; and
- (4) a tube squeezing slide movably mounted in the channel so that the slide can progressively engage and collapse the tube to expel substantially all of the shaving cream from the collapsible tube.

None of these elements, either alone or in combination, are taught or suggested in the prior art.

The instructions state that points will be deducted for claiming unnecessary limitations. So even under the petitioner's interpretation of the question asked, he has not demonstrated that points needed for a passing grade would not have been deducted for claiming unnecessary limitations.

The petitioner further argues that both the "longitudinal sides" feature and the "opposed slots" feature are not part of the main object of the invention but are merely referred to in the Objects of the Invention paragraph as a part of a "further object" of the invention. Thus, the petitioner argues, absence of those features in generic claim 1 is nonetheless permissible.

The argument is without merit. In the Objects of the Invention paragraph, the sentence stating the main object of the invention identifies no structural component of the invention whatsoever. It states merely that: "The main object of the invention is to provide a shaving implement which can dispense shaving cream for the life of the razor." Also, all structural components are described in the particular description which follow in that same paragraph in a statement about a further object of the invention.

A claim to a shaving implement cannot be without any structural component. That, however, is what results if the petitioner is correct that all he needs to do is define a shaving implement as set forth in the main objective of the invention. It would be unreasonable to interpret the requirement of defining the invention as set forth in the Objects of the Invention paragraph as permitting one to disregard the "further object" statement which sets forth all of the structural components referred to in the paragraph and

how they interrelate to each other. The entirety of the Objects of the Invention paragraph must be accounted for.

And if we assume that the petitioner need only define that which appears in the main objective of the invention, it is manifestly evident that too many elements have been included in petitioner's claim 1 and additional points should be deducted. The petitioner has not shown that the points he seeks should not otherwise be deducted for including unnecessary limitations in the claim.

The petitioner does not dispute that the "opposed slots" feature of the slide in the shaving implement is described within the Objects of the Invention paragraph. It is also undisputed that that limitations is not included, either expressly or implicitly, within petitioner's claim 1. Thus, for that deficiency, five points were properly deducted from the petitioner's score.

The petitioner asserts an alternative argument which applies in the event this decision holds that the "longitudinal sides" limitation of the channel is a necessary limitation. In that regard, the petitioner states:

Even assuming, arguendo, that this limitation [channel has longitudinal sides] is "necessary" my claim 1 includes the limitation. My exam answer reads: "a channel defined by the topside of the handle, the channel communicating over substantially its entire length with the chamber." I respectfully

submit that any channel will inherently have longitudinal sides. It is unfair to penalize me five points for not including "longitudinal sides", when I have claimed the channel, and the channel will inherently have longitudinal sides. The addition of the words "longitudinal sides" adds absolutely nothing to the limitation provided by the term "channel". I respectfully submit that my exclusion of the words "longitudinal sides" is inconsequential.

While not agreeing with all of the petitioner's assertions, I am persuaded that one may reasonably regard petitioner's claimed channel to have, inherently, longitudinal sides. However, that is not enough to award the petitioner any additional points. As the Director correctly determined, in light of description in the Objects of the Invention paragraph, petitioner has not interrelated the channel's longitudinal sides to the opposed slots of the slide. Stating that the slide is movably mounted in the channel is inadequate.

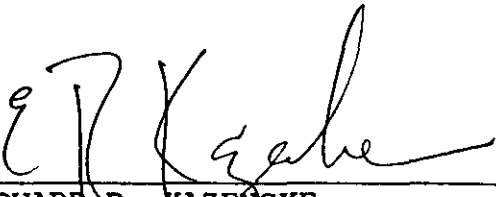
It should be noted that the required engagement or contact between the channel's longitudinal sides and the slide, whether or not through opposed slots on the slide, is by no means inherent. Accordingly, it is not enough that petitioner's channel may inherently have longitudinal sides. While petitioner failed to claim opposed slots on the slide, that did not preclude petitioner from drafting a claim which

interrelates the slide and the channel's longitudinal sides as is made clear in the Objects of the Invention paragraph.

CONCLUSION

For the foregoing reasons, the petitioner is not entitled to any additional points on his score of 62 achieved on the afternoon section of the registration examination held on October 13, 1993. Accordingly, upon consideration of the petition to the Commissioner, filed under 37 CFR § 10.2(c), it is herein ORDERED that the petition is denied.

MAY 3 1994



EDWARD R. KAZENSKE
Director of Interdisciplinary
Programs

cc: